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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/032,849

10/29/2001

Sridatta Viswanath

5681-91000

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08/19/2008

MHKKG/SUN

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EXAMINER

EVANS, KIMBERLY L.

ART UNIT

PAPER NUMBER

3629

MAIL DATE

DELIVERY MODE

08/19/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/032,849	Applicant(s) VISWANATH ET AL.	
	Examiner KIMBERLY EVANS	Art Unit 3629	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period **will** apply and **will** expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply **will**, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 October 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 29 October 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>1/13/05</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Status of Claims

1. This action is in reply to the application filed on October 29, 2001.
2. Claims 1-22 are currently pending and have been examined.

Information Disclosure Statement

3. The Information Disclosure Statement filed on January 13, 2005 has been considered.
An initialed copy is enclosed herewith.

Claim Rejections - 35 USC § 101

4. The following is a quotation of the first paragraph of 35 U.S.C. 101:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.
5. Claims 1-22 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The aforementioned claims are directed toward providing information in relation to an electronic communication device via a data signal. However, under the current guidelines of 35 USC 101, computer software must be tangibly embodied on a computer readable medium, and, when executed by a computer processor, perform the steps of the software. In their broadest reasonable interpretation and in light of the specification, claims 1-22 as recited, can be interpreted to be embodied

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on abstract mediums such as carrier waves and signals, and therefore not eligible for patent protection. Accordingly, these claims are not eligible for patent protection.

6. Claims 1-22 do not qualify as a statutory process since they recite purely mental steps. To qualify as a § 101 statutory process, the claim should positively recite the other statutory class (thing or product) to which it is tied. For example, by identifying the apparatus that accomplishes the method steps, or positively recite the subject matter that is being transformed, for example by identifying the material that is being changed to a different state. The claim language in the aforementioned claims does not include the required tie or transformation which would provide the application of the test to the claims to reach the conclusion of nonstatutory subject matter.
7. In order for a method to be considered a "process" under §101, a claimed process must either: (1) be tied to another statutory class (such as a particular apparatus) or (2) transform underlying subject matter (such as an article or materials). *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972). If neither of these requirements is met by the claim, the method is not a patent eligible process under §101 and is non-statutory subject matter. Therefore claims 1-22 are rejected under 35 U.S.C. 101.
8. Claims 1, 8, and 15 are rejected under 35 U.S.C. 101 because the claimed component is interpreted as being software per se; software does not fall within a statutory category of patentability.

Claim Rejections - 35 USC § 102

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

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A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

10. Claims 1-6, 8-13, and 15-21 are rejected under 35 U.S.C. 102(b) as being anticipated by
Perkowski et al US Patent Application Publication No US 2004/0210479 A1

11. With respect to Claims 1 and 8,

Perkowski discloses the following limitations:

- *inputting an action to a client computer; performing said action by said provider; calling a helper class method corresponding to said action and a corresponding render method by said provider; (see at least paragraph 70: "...Another object of the present invention is to provide client-side and server CPIR-enabling Java Applets for enabling the consumer product information searches at virtually any consumer point of presence on the WWW by performing a single mouse-clicking operation..."; paragraph 72: "...Another object of the present invention is to provide a novel Internet-based system and method, wherein each publisher is provided with a computer-based publishing system, which enables the electronic layout of: (i) a Web-based publication (e.g. expressible in HTML or SGML code) having different content and advertising sections associated with each Web-page thereof and each such Web-page being located on the WWW at a particular URL...")*
- *populating a name value pair with corresponding data by said render method; applying said name value pair populated with said data to a vehicle for displaying dynamic content on pages in a high order presentation language; and drafting said second page in a high order presentation language. (see at least paragraph 24: "...consumers can access and display information menus containing UPC numbers linked to URLs pointing Web pages containing consumer product related information*

by scanning the UPC label on the consumer product or by entering the UPC number thereof into a data-entry screen displayed by the system in this mode..”; Figure 5E, paragraph 320: “...FIG. 5E is a schematic diagram illustrating the high level structure of a communication protocol that can be used among the client subsystem C.sub.a, the IPD Server S.sub.b, and the IPI Server S.sub.c of the IPI Finding And Serving Subsystem hereof when the subsystem is in its Product-Description Directed Search Mode of operation, requesting as input a product descriptor related to the consumer product on which information is sought and providing as output the trademark, company name and URL(s) related to the product descriptor within the database of the system and pointing to HTML-encoded documents containing particular types of product-related information. ..”; paragraph 1086: “...As shown in FIG. 15AA, the RDBMS table entitled VIRTUAL KIOSK USER ACTIVITY, showing its primary information fields, namely: Date(s) of Activity Measurement; Virtual Kiosk ID No.; Number of HTML Pages Accessed; Number of BrandKey Requests at Kiosk; Number of Trademark Requests; Different HTML Pages Served-Up; Outgoing E-Mail transmissions; System Mode Transitions; E-commerce Transactions Made; and Date of Last Record Update. This data table maintains information on each e-mail transmission made from each virtual kiosk deployed within the system. Such e-mail related information can be valuable to retailers and manufacturers alike who seek to acquire new and retain current customers...”; paragraph 1722: “...2.1.23. The System will click the Confirm button to save the changes they have made and the System will return them to the first page in the Search/Edit User Service. [See Alternate Flow 2.2.4 if the Edit button is clicked]...”; paragraph 2053: “...2.1.5. The System will save the number to the Database and display the next page (Select Node Indices page--see appropriate Use Case)...”)

12. With respect to Claims 2, 9, and 17,

Perkowski discloses all of the above limitations, Perkowski further discloses:

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- *said high order presentation language comprises HyperText Markup Language (HTML).* (see at least paragraph 506: "...the URL stored in the URL Information Field specifies the address of an information resource on the Internet (e.g. Web), and thus may point to any one of the following types of information resources: a HTML document or file on the World Wide Web (expressed in the Hypertext Markup Language); a single record in a database; the front-end of an Internet program such as Gopher; or the results of a query made using another program. In accordance with convention, the syntactic structure of each URL generally comprises: a Protocol Specifier, such as "http", "ftp", "gopher", "news", or "mail to", and specifies the type of resource that the URL is pointing (i.e. connecting) to; a Host Indicator, represented by double slashes "/" if the URL is requesting information from a Web Server; Server Name comprising an Internet Domain Name (e.g. "www."), the address of the Web Server (e.g. "ibm."), and a designator (e.g. "com", "edu", "int", "mil", "net", "org", etc.) identifying who owns the server or where it is located; a Path Name, such as "Products/Computers/", indicating a path to the destination information file on the identified Server; and a Resource Name (including file extension, e.g. ".html"), such as "aptiva.html", identifying the actual named information file that contains actual information resource specified by the URL...")

13. With respect to Claims 3, 10, and 18,

Perkowski discloses all of the above limitations, Perkowski further discloses:

- *wherein said first page, said second page, and said pages comprise HTML pages.* (see at least paragraph 1086: "...As shown in FIG. 15AA, the RDBMS table entitled VIRTUAL KIOSK USER ACTIVITY, showing its primary information fields, namely: Date(s) of Activity Measurement; Virtual Kiosk ID No.; Number of HTML Pages Accessed; Number of BrandKey Requests at Kiosk; Number of Trademark Requests; Different HTML Pages Served-Up; Outgoing E-Mail transmissions; System Mode Transitions; E-commerce Transactions Made; and Date of Last Record Update. This

data table maintains information on each e-mail transmission made from each virtual kiosk deployed within the system. Such e-mail related information can be valuable to retailers and manufacturers alike who seek to acquire new and retain current customers..."; paragraph 1722: "...2.1.23. The System will click the Confirm button to save the changes they have made and the System will return them to the first page in the Search/Edit User Service. [See Alternate Flow 2.2.4 if the Edit button is clicked]..."; paragraph 2053: "...2.1.5. The System will save the number to the Database and display the next page (Select Node Indices page--see appropriate Use Case)...")

14. With respect to Claims 4, 11, and 19,

Perkowski discloses all of the above limitations, Perkowski further discloses:

- *said provider of server-side processing deployed upon a server comprises a servlet.* (see at least paragraph 451: "...In the system architecture set forth in FIG. 2B1, server-side Applets ("Servlets"), having their <SERVLET>HTML tags embedded within HTML documents (e.g. the HTML 3.2 Specification), are executed within Java-enabled Web servers on the server-side of the information network...")

15. With respect to Claims 5, 12, and 20,

Perkowski discloses all of the above limitations, Perkowski further discloses:

- *said form comprises a business form* (see at least paragraph 433: "...While the illustrative embodiment of this Web-based Document Transport System has been described in terms of its implementation using the WebDox.TM. system from Premenos, it is understood that other commercially available electronic document transport systems (e.g. COMMERCE: FORMS.TM. Electronic Business Forms Package from Sterling Commerce, Inc., <http://www.stercomm.com>) can be used to carry out this subsystem. The operation of this Web-Based Document Transport

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System will be described in detail hereinafter with respect to the collection and delivery of consumer product-related information to the IPDs hereof...")

16. With respect to Claims 6, 13, and 21,

Perkowski discloses all of the above limitations, Perkowski further discloses:

- *said business form comprises a modality for performing an electronic commerce transaction*' (see at least paragraph 32: "...electronic-type commercial transactions involving the purchase of products, which are advertised on the Internet at uniform resource locations (URLs) that are registered with the IPI system of the present invention..."; paragraph 50: "...provide a novel method of and system for accessing consumer product related information at points within HTML-encoded documents, at which Universal Product Number (UPN) encoded Java Applets are embedded so as to produce, when executed, a consumer product information display enabling ("CPID-enabling") Java-based graphical user interfaces (GUIs) for the convenience of consumers shopping at electronic-commerce (EC) enabled stores, considering the placement of bids at on-line auction sites, or browsing product advertisements appearing on the World Wide Web..."; paragraph 433: "...illustrative embodiment of this Web-based Document Transport System has been described in terms of its implementation using the WebDox.TM. system from Premenos, it is understood that other commercially available electronic document transport systems (e.g. COMMERCE: FORMS.TM. Electronic Business Forms Package from Sterling Commerce, Inc., <http://www.stercomm.com>) can be used to carry out this subsystem. The operation of this Web-Based Document Transport System will be described in detail hereinafter with respect to the collection and delivery of consumer product-related information to the IPDs hereof...")

17. With respect to Claim 15,

Perkowski discloses all of the above limitations, Perkowski further discloses:

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- *a client computer displaying a first page in a high order presentation language, wherein said first page is associated with a form; (see at least paragraph 115: "...Another object of the present invention is to provide an Internet-based consumer product marketing, merchandising and education/information system, wherein the UPN/TM/PD/URL link creation, management and transport software running on each manufacturer-operated/m- anaged client computer subsystem has a graphical user interface (GUI) which comprises a number of display structures.."; paragraph 1722: "...2.1.23. The System will click the Confirm button to save the changes they have made and the System will return them to the first page in the Search/Edit User Service. [See Alternate Flow 2.2.4 if the Edit button is clicked]....")*
- *a server computer comprising a provider of server-side processing, wherein said form is correspondingly mapped to said provider, wherein upon inputting an action to said client computer, said provider executes a method of generating a second page in a high order presentation language, said method comprising: performing said action by said provider; calling a helper class method corresponding to said action and a corresponding render method by said provider; populating a name value pair with corresponding data by said render method; applying said name value pair populated with said data to a vehicle for displaying dynamic content on pages in a high order presentation language; (see at least Paragraph 238: "...FIG. 2B1 is a block schematic diagram of the IPD Server of the first illustrative embodiment, showing its subsystem components namely a RDBMS server and a Java Web Server with Java servlet support, being accessed by a Java-enabled client machine seeking to access consumer product related information from the RDBMS server using server-side Java Applets whose HTML tags are embedded within HTML-encoded documents served to the client machine from any one of a number of potential http information servers on the Internet...")*

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- *drafting said second page in a high order presentation language to minimize redundancy in operating code by re-use of applicable portions of said code. (see at least paragraph 58: "...provide such an Internet-based consumer product information collection, managing and delivery system and method, wherein licensed users can download CPIR-enabling Applets from the CPIR-Enabling Applet Library to any client computer for eventual insertion within the HTML code of a particular Web-document to be published on the Internet in accordance with the licensing arrangement between the contracting parties. Such end-use applications might be in EC-enabled retail product catalogs, EC-enabled wholesale/trade catalogs, Internet-based product advertisements, on-line auction WWW sites, on-line stock trading WWW sites, and the like. .."; paragraph 4103: "...2.1.7. The User may update the Client Account Information and click the Next button to save changes and move on to the next page..")*

18. With respect to Claim 16,

Perkowski discloses all of the above limitations, Perkowski further discloses:

- *said system is an electronic commerce system (see at least paragraph 68: "...Another object of the present invention is to provide a novel Internet-based electronic commerce (EC) enabled shopping system comprising an Internet information server connected to the infrastructure of the Internet and supporting the hypertext transmission protocol (http), a Web-enabled client subsystem connected to the infrastructure of the Internet, an EC-enabled WWW site comprising a plurality of interlinked HTML-encoded documents arranged and rendered to provide an electronic store environment when served to a consumer operating the Web-enabled client subsystem, wherein the electronic store environment presents a plurality of products for purchase and sale by an EC-enabled payment method supported over the Internet. ...")*

Claim Rejections - 35 USC § 103

19. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

20. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

- i. Determining the scope and contents of the prior art.
- ii. Ascertaining the differences between the prior art and the claims at issue.
- iii. Resolving the level of ordinary skill in the pertinent art.
- iv. Considering objective evidence present in the application indicating obviousness or nonobviousness.

21. Claims 7, 14, and 22 are rejected as being unpatentable over Perkowski et al US Patent Application Publication No US 2004/0210479 A1 in view of Gardner et al., US Patent Application Publication no US 2002/0077958 A1.

22. With respect to Claims 7, 14, and 22,

Perkowski discloses all of the above limitations, Perkowski does not disclose the following limitations, but Gardner however as shown discloses:

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- *said vehicle for displaying dynamic content on pages in a high order presentation language comprises a Java Server Page (JSP).* (see at least paragraph 10: "...The system also includes a front-end, which includes: a user interface, a controller coupled to the user interface, and a business process router coupled to the controller. In a preferred embodiment, the front end architecture includes Java server pages, a controller, and a business process router. The server side architecture includes a plurality of business processes, which are implemented by a plurality of Enterprise JavaBeans, and a notification manager as a messaging daemon. The plurality of Enterprise JavaBeans implements, among others, the request-for-quotation, the quotation, and the purchase order processes....")

It would have been obvious to one ordinary skilled in the art at the time of the invention to combine the Internet-based brand marketing communication system of Perkowski with the supply-based management system of Gardner because a supply-based management system in a network environment would increase the efficiency of the plurality of business processes.

Conclusion

23. Any inquiry of a general nature or relating to the status of this application or concerning this communication or earlier communications from the Examiner should be directed to **Kimberly L. Evans** whose telephone number is **571.270.3929**. The Examiner can normally be reached on Monday-Friday, 9:30am-5:00pm. If attempts to reach the examiner by telephone are unsuccessful, the Examiner's supervisor, **John Weiss** can be reached at **571.272.6812**.

24. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status

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information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://portal.uspto.gov/external/portal/pair> <<http://pair-direct.uspto.gov> >. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at **866.217.9197** (toll-free). Any response to this action should be mailed to: **Commissioner of Patents and Trademarks**, P.O. Box 1450, Alexandria, VA 22313-1450 or faxed to **571-273-8300**. Hand delivered responses should be brought to the **United States Patent and Trademark Office Customer Service Window**: Randolph Building 401 Dulany Street, Alexandria, VA 22314.

/Kimberly Evans/Examiner, Art Unit 3629

August 18, 2008

/John G. Weiss/

Supervisory Patent Examiner, Art Unit 3629